

JPO DESIGN PRACTICE

>Effects of design right

Effects of design right are defined in Article 23 of the Japan Design Act as shown in the following." A holder of a design right shall have the exclusive right to work the registered design and designs similar thereto as a business." Effects of the design right are extended to a design similar to a registered design (Article 23).

>Test of design similarity

In a phase of examining a filed design by Examiner, a prior art of design identical or *similar* to a design filed may serve as bar to block issuing a design right. In an enforcement, a holder of a design right can exercise its exclusive right to manufacture or sell et al an article applied by an identical design registered, and a *similar design* to registered.

So, it should be essentially considered what a similar design is” Meanwhile, it had been argue in practices and academies if who should be a viewer when assessing similarity of design, consumers or designers, and what to nature and extent of “similarity” refers to, *i.e.* a same scope of design value or a relation causing a likelihood of confusion. The revised Design Act in 2006 put it by statutory solution with adding the provision in Article 24(2) clause as read;

Whether a registered design is identical with or similar to another design shall be determined based upon the aesthetic impression that the designs would create through the eye of their consumers.

A test to evaluate a similarity of design clearly became conclusive. Eventually it is now required to evaluate a similarity of design from a point of view of consumers, and to consider a design if it creates another aesthetic impression in comparison to another.

>Design inseparable from article

"Design" means the shape, patterns or colors, or any combination thereof, of an article, which creates an aesthetic impression through the eye (Article 2(1)), and therefore, a design should be inseparable from an article to which it is applied.

>Graphic image on a screen

A computer icon may be protected as a graphic image on a screen because Article 2(2) stipulates "The shape, patterns or colors, or any combination thereof, of a part of an article as used in the preceding paragraph shall include those in a graphic image on a screen that is provided for use in the operation of the article (limited to the operations carried out in order to enable the article to perform its functions) and is displayed on the article itself or another article that is used with the article in an integrated manner." The design including image display may only be protected under the Japan Design Act if the image fulfilled the following two requirements:

- (1) graphic image for the operation (limited to the operation for keeping the article concerned in an operative condition for consummating its function) of the article, and;
- (2) graphic image shown on the article concerned or the article used as an integral part

thereof.

Meanwhile, a wallpaper for computer is not protected, as this kind of image is not used for operation.

Further, one scene of a game and a computer icon are not also protected, as this kinds of images are generated as a result of performing their functions.

>Definition of obvious design

Obviousness of a design is defined in Article 3(2) of the Japan Design Act as shown in the following.

"Where, prior to the filing of the application for design registration, a person ordinarily skilled in the art of the design would have been able to easily create the design based on shape, patterns or colors, or any combination thereof that were publicly known in Japan or a foreign country, a design registration shall not be granted for such a design, notwithstanding the preceding paragraph."

Prior art for evaluating obviousness

The scope of the relevant prior art of evaluating obviousness under Article 3(2) extends to all analogous arts. The analogous arts include not only a surface ornamentation on an article, but also a scheme of surface ornamentation, which is separable from an article.

Level of a person with ordinary skill in the art

"A person ordinarily skilled in the art of the design" provides a hypothetical person who has the common general knowledge as of the filing in the field of manufacturing or selling an article of a design.

Examples of obvious designs

Examples of obvious designs are below.

- (1) Designs created by replacing an element of publicly known design with other publicly known design by the ordinary technique for skilled person.
- (2) Designs created by aggregating a plurality of publicly known designs by the ordinary technique for skilled person.
- (3) Designs created by changing layout of each element in publicly known designs by the ordinary technique for skilled person.
- (4) Designs created by changing dimension of publicly known designs, and increasing or decreasing the number of consecutive elements of publicly known designs.
- (5) Designs created by applying publicly known shape, pattern, or color, or combination thereof as it is on an article.
- (6) Designs created by conversion of a design to an article based on common commercial usage.

>Single application per design

In Japan, an application for design registration should be filed relating to a single design according to the classes of articles prescribed by the Ordinance of the Ministry of Economy, Trade and Industry (Japan Design Act Article 7). This is called “one application per design system.” Therefore, plural designs should not be depicted in one set of drawings. Further, “the article to which the design is applied” must be described according to the classes of articles of the Ministry Ordinance, and an applicant may not freely describe it. Exceptionally, there is a system which is called Design for set of articles.

Design of two or more articles that are used together as a set of articles, and the design for the set of articles is coordinated as a whole, an application may be treated as for one design (Japan Design Act Article 8). For example, a dinner set and a coffee set belong to this kind of design.

>Partial design

Definition

According to Article 2 (1), "Partial Design" means the shape, patterns or colors, or any combination thereof (referred to as "appearance"), of a part of an article. Therefore, in the Japan Design Act, the design may be not only an appearance of a whole of an article (referred to as "Whole Design") but also an appearance of a part of an article (that is, "Partial Design").

According to the Examination Guideline (71.1) for Designs of JPO, the requirements for being a "Partial Design", in brief, are as follows:

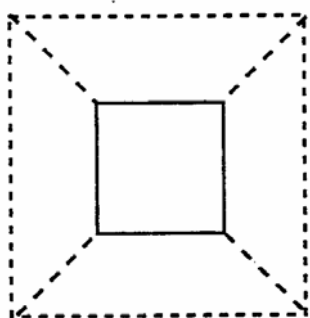
- (1) A "Partial Design" shall be industrially applicable (Article 3 (1)),
- (2) A "Partial Design" shall be a portion covered with a certain spread in an appearance of a whole of an article,
- (3) A "Partial Design" shall be a portion which is a comparable object included in an article, when being compared with other designs.

Application and drawings

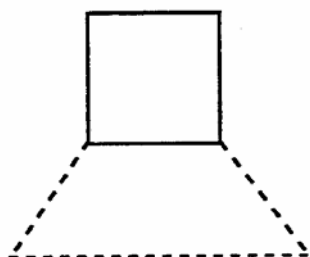
When an applicant requests a design registration of a "Partial Design", the applicant shall state such an intention in the application and specify the "Partial Design" by depicting the portion of the "Partial Design" with solid lines and the other portions of the "Whole Design" in which the "Partial Design" is contained with broken lines in the drawings. And also in the application the applicant shall explain how to specify the "Partial Design" in the drawings.

JPO shows the following examples in its site.

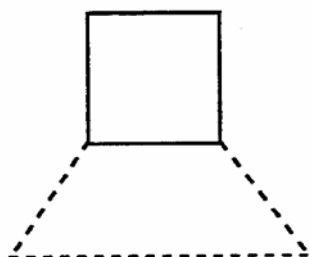
[top view]



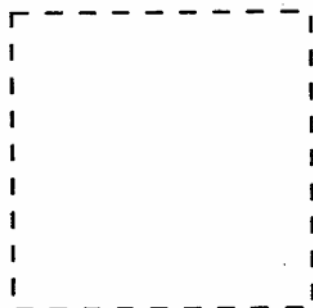
[front view]



[right-side view]



[bottom view]



Requirement particular to the registration of a "Partial Design"

In order to obtain the registration of a "Partial Design", in addition to the regular requirements such as industrial applicability, novelty and non-obviousness (Article 3), the requirement prescribed in Article 3-2 shall be filled.

According to the main clause of Article 3-2, the application for a "Partial Design" identical with or similar to a part of a design described in an earlier application shall be refused on the basis of the design described in the earlier application.

However, in the case where the applicant of an application for a "Partial Design" is the same person as that of an earlier application, the main clause of Article 3-2 shall not apply to the application for the "Partial Design" which is filed on or after the filing date of the earlier application and before the issuing date of the Design Gazette (Design Bulletin) in which the earlier application is published (the proviso of Article 3-2).

>Related design

Definition

According to Article 10 (1), "Related Design" means a design similar to another design (referred to as "Principal Design") selected from the design(s) in the same applicant's other application(s).

Requirements

The Examination Guideline for Designs (73.1) of JPO explains that in order to obtain the design registration of the "Related Design", its application shall fulfill the following requirements:

- (1) The applicant of the "Related Design" shall be the same person as that of the "Principle Design";
- (2) The design in the application for the "Related Design" shall be similar to the "Principle Design";
- (3) The application for the "Related Design" shall be filed on or after the filing date of the application for the "Principle design" and before the issuing date of the Design Gazette (Design Bulletin) in which the application for the "Principle Design" is published.

When the application for the "Related Design" fulfills the above requirements, the application for the "Related Design" is not refused on the basis of the similarity with the "Principle design".

And furthermore it should be noted that the application for a design that is similar only to a "Related Design" to be registered under Article 10 (1) is refused (Article 10 (3)) and also that, when the applications for two or more "Related Designs" pertaining to the "Principal Design" are filed, the applications for these "Related Designs" are not refused on the basis of each other (Article 10 (4)).

Design right

With regard to the design right of the "Related Design", the following matters shall be considerable.

The design right of the "Related Design" expires after 20 years from the date of the

registration of the establishment of the "Principle Design" (Article 21 (2)).

The design right of the "Related Design" may not be transferred independently of that of the "Principle Design" (Article 22 (1) (2)).

The exclusive license on the design right of the "Related Design" may not be granted separately from that on the design right of the "Principal Design". When the holder of design rights of the "Principal Design" and the "Related Design(s)" intends to grant the exclusive license on the design right of the "Principal Design" and/or that on the design right(s) of the "Related Design(s)", the exclusive license on the "Principal Design" and all the "Related Design(s)" thereof shall be granted to the same person at the same time (Article 27 (1) (3)).

>Flow in securing design right

To obtaining a design registration, an application needs to file with the JPO. The application for request of design protection will essentially track on the flow described below.

See attached.